

REMARKS

The Office Action dated April 5, 2004 has been carefully considered and applicant respectfully request reconsideration of the present application in view of the reasons that follow.

Miscellaneous Claim Amendment

Claim 30 has been amended from several erroneous versions of the claim previously submitted by applicant. Specifically, the word "partial" mistakenly remained in several previous versions of the claims, despite being deleted in the Amendment dated December 20, 2002. The present listing of the claims is now believed to accurately reflect the past prosecution.

Claim Rejections Based Upon Alvarez et al U.S. Patent No. 6,370,413

In the Office Action, claims 1-3, 6-7, 11-14 and 17-22 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Wood (U.S. Patent No. 5,715,823) and Alvarez et al (U.S. Patent No. 6,370,413), and further in view of Hossack et al. (U.S. Patent No. 6,511,426). Claims 23 and 26-32 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Wood (U.S. Patent No. 5,715,823) and Alvarez et al (U.S. Patent No. 6,370,413).

On February 13, 2004 applicant submitted a Request for Continued Examination and a Declaration under 37 C.F.R. § 1.131(b) demonstrating that the Alvarez et al '413 patent is, in fact, not prior art against the present application and thus does not support a proper basis for the above rejections. The Declaration under 37 C.F.R. § 1.131(b) included the following Exhibits:

- Exhibit A: A copy of a transmittal letter dated August 30, 1999 from the applicant to attorneys for the applicant transmitting invention disclosures for eight (8) inventions.
- Exhibit B: A copy of an undated invention disclosure for the present application sent with the transmittal letter of Exhibit A.

- Exhibit C: A copy of an Administrative record documenting receipt and acceptance of the offer to prepare a patent application on the invention disclosure shown in Exhibit B on September 9, 1999.

As stated by the Examiner, the Declaration under § 1.131 establishes conception of the present invention prior to August 30, 1999. This conception date, which is not provided as the absolutely earliest conception date, is prior to the filing date of the Alvarez et al '413 patent, November 2, 1999.

However in the Office Action, the Examiner states that there was insufficient evidence submitted with the Declaration under 37 C.F.R. § 1.131(b) to establish diligence from a date prior to the priority date of the Alvarez '413 patent up until the constructive reduction to practice of the present invention, i.e. the filing of the present application, November 24, 1999. Applicant respectfully traverses this decision.

Herewith applicant submits Exhibits D and E which, together with Exhibits A, B and C, clearly demonstrate diligence from a date prior to the filing date of the Alvarez '413 patent up until the constructive reduction to practice of the present invention.

Referring first to Exhibits A and B, the applicants mailed eight (8) technical invention disclosures to the preparing attorney on August 30, 1999; and, as shown in Exhibit C, the attorney subsequently received and then accepted the engagement to prepare patent applications based on these disclosures on September 10, 1999. All eight of these disclosures involved related features of a new, complex picture archival and communications (PACS) system. Patent applications for at least five of these disclosures were simultaneously and diligently prepared in a timely fashion, and in fact three of the applications were ultimately filed on the same date. More specifically:

- Patent Application for Integrated PACS/RIS System (Docket #15-IS-5288), U.S. Patent Application No. 09/543,663, was filed on 4/5/2000;
- Patent Application for 3D Imaging on a PACS Workstation (Applicant Docket #15-IS-5289), U.S. Patent Application No. 09/449,701, was filed on 11/24/1999;

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- Patent Application for a Secondary Capture of a 3D-based Images on a PACS system (Applicant Docket #15-IS-5290), U.S. Patent Application No.09/449,215 was filed on 11/24/1999;
- Patent Application for Process-Integrated PACS/RIS System (Docket #15-IS-5293), U.S. Patent Application No. 09/474,569, was filed on 12/29/1999; and
- Patent Application for Memory Management System for a PACS Workstation (Docket #15-IS-5297), U.S. Patent Application No. 09/476/618, was filed on 12/31/1999.

Referring to Exhibit D, the attorney sent a letter on November 15, 1999 to the inventors in the present application, enclosing a first draft of the present patent application. This letter was sent only 13 days after the priority date of the Alvarez et al '413 patent, November 2, 1999. As discussed below, this letter evidences the diligence of the attorney in preparing the present patent application during the critical time period.

Referring to Exhibit E, the inventors sent an email transmission on November 23, 1999 to the attorney providing address information for each of the inventors. Note that information for the inventors on the two other related applications noted above is also included. Also note that some of the inventors live in different parts of the country and even the world.

Referring to Exhibit F, the inventors sent a facsimile transmission on November 23, 1999 to the attorney providing comments/changes to the application and requesting further conversation regarding the application.

One day later, November 24, 1999, the patent application was filed with the U.S. Patent Office.

By the above Exhibits and the previously submitted Declaration, diligence on the part of the attorney in preparing and filing the present application during the critical period is clearly shown. MPEP § 2138.06 states that "Reasonable diligence is all that is required of the attorney", *Bey v. Kollonitsch*, 866 F.2d 1024, 231 USPQ 967 (Fed. Cir.

1986), and “Work on a related case(s) that contributed substantially to the ultimate preparation of an application can be credited as diligence.” *Id.* See also *Watkins v. Wakefield*, 443 F.2d 1207, 170 USPQ 274 (CCPA 1971) (When a number of related patents by the same inventor were worked on as a group by a single attorney, with no specific priority between them, it constituted as sufficient diligence over a **41 day critical period** despite it taking **eighteen months** total to file the patent applications.). The present application was a part of a group of eight (8) invention disclosures, for which at least five (5) applications were simultaneously prepared and later filed, three of which on the same day. These applications have many of the same inventors and were directly related in subject matter, as all were complex inventions dealing with three-dimensional imaging in a picture archival and communication system (PACS). The disclosures were initially sent to the attorney on August 30, 1999 and within 66 days the attorney prepared and sent drafts of at least three applications, including drawing figures to the inventors for review. Certainly, this factual scenario constitutes diligence on the part of the attorney during the critical period. *Id.*

A draft of the present application was sent to the inventors for review on November 15, 1999 (Exhibit D) and each inventor reviewed the final application prior to filing (see the Declaration in the present application). Even though some of the inventors live in different parts of the country and the world (Exhibit E), the application was timely returned after review no later than November 22, 1999. This review by the inventors took only one week, well within the proscribed time period for diligence. *Sletzinger v. Lincoln*, 410 F.2d 808, 161 USPQ 727 (CCPA 1969) (Up to at least a two-week delay for the inventors to review the application is reasonable.)

Accordingly, in view of the Declaration of Prior Invention of January 9, 2004 and associated Exhibits A-C and new Exhibits D-F, the conception date prior to the filing date of the Alvarez et al ‘413 patent has been established, as well as diligence of the attorney for the applicants during the critical period of November 2, 1999 to November 24, 1999.

Applicant reasserts that Alvarez et al '413 is not prior art under 35 U.S.C. § 102(e) and thus may not be applied in a rejection under 103(a).

In light of the above arguments, Applicants respectfully request that the Examiner withdraw the rejection of claims 1-3, 6, 7, 11-14, 17-23 and 26-32, or further cite a basis for the assertion of lack of diligence.

Remaining Claim Rejections

Claims 1, 6, 14, 17, 18, 23, 27 and 29 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Udupa, et al U.S. Patent No. 5,812,691 and Chong, et al, "*Concurrent Processing for Picture Archiving and Communication System*" (PACS).

The Examiner is correct that Udupa, et al '691 fails to teach the claimed image management system wherein the PACS workstation has an output coupled to the PACS server and configured to provide the PACS server with a signal representative of the three dimensional rendering. However, applicant strongly disagrees with the Examiner's opinion that this feature is exceedingly well known in the art. The only evidence the Examiner cites for his opinion is the Chong, et al publication. However, Chong, et al fails altogether to teach a PACS workstation having an output coupled to the PACS server and configured to provide the PACS server with a signal representative of the three dimensional imaging. In contrast, the passage cited by the Examiner in Chong, et al teaches only compressing medical data from two-dimensional JPEG images. There is no teaching or suggestion of a PACS workstation that has an output coupled to a PACS server and configured to provide the PACS server with a signal representative of the three dimensional rendering. This concept is shown nowhere in the prior art, and contrary to the Examiner's opinion, was not well known in the art at the time of the filing of the present application. With nothing further, applicant respectfully requests that the Examiner withdraw the outstanding rejections. MPEP § 2144.

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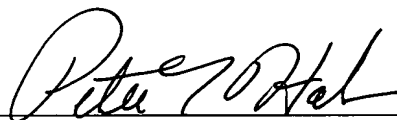
Conclusion

Applicants believe that the present application is now in condition for allowance and favorable reconsideration of the application as amended is respectfully requested.

Respectfully submitted,

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